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09/490,495 01/25/00 BLUMENAU

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EXAMINER

TM02/0717

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ART UNIT	PAPER NUMBER

2165
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/490,495

Applicant(s)
Blumenau

Examiner
Cuong H. Nguyen

Art Unit
2165



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 4, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-241 is/are pending in the application.
- 4a) Of the above, claim(s) 1-65 and 86-100 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 66-85 and 101-241 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 10 20) ☐ Other: _____

S.N.: 09/490,495
Art Unit: 2165

DETAILED ACTION

1. This Office Action is the answer to the communication received on 5/04/2001 (the amendment), which paper has been placed of record in the file.
2. Claims **66-85**, **101-241** are pending in this application; claims **182-241** have been added.

Drawings

3. This application has been filed with informal drawings, and they are required to be corrected as indications of the draftsman.

Response to Amendment

4. Applicant' arguments received by PTO on 5/04/2001 (claimed 4/30/01) have been fully considered **but they are not persuasive** with previous cited references for 35 U.S.C. §103(a) rejections **since they are very broad**. The examiner submits that new claims **182-241** comprise features that analyzed in previous Office Action or they are very obvious from previous analysis using previous cited prior art, or only implemented for "content display monitoring" using available computer technologies. All previous rejections on 35 USC 101 are withdrawn from the explanation of the applicant.

Specification Objection

5. The disclosure was objected to because of the following informality:

The title of the invention is not descriptive. A new title was required that is clearly indicative of the invention to which the claims are directed.

The following title was suggested: "Content display monitoring by a computer system" (because the specification is directed toward monitoring contents using computer system).

Appropriate correction is required (this correction was omitted in last response).

6. The examiner submits that the reasons for rejection are obvious (v.s. cited prior arts) with **claims' language**. In re **Mratz**, 59 CCPA, F.2d, 173 USPQ 25, 28 (1972), the court ruled: "Claims which are broad enough to read on obvious subject matter are unpatentable even though they also read on nonobvious subject matter". This application contains all independent claims that are "read on" from cited arts, since they are very broad in a notoriously well-known field as "content display monitoring".

7. In re **Van Geuns**, 26 USPQ2d 1057 (CA FC 1993), the court rules: Although claims are interpreted in light of the specification, limitations from the specification are not read

into the claims (e.g. arguments on claim 66 (pg.23, 3rd para.), and pp. 36 (3rd para.) To pg. 37, (1st para.).

8. *In re Prater*, 162 USPQ 541 (CCPA 1969), the court ruled: During patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. Reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is quite different from reading limitations of the specification into a claim, to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim.

9. Re. to claims 66, 225: This claim has 2 limitations of:

- monitoring positions of displays on computer screens;
- evaluating those obtained data.

These method claims lack structural limitations, and explanations of HOW to do "monitoring", and "evaluating".

10. Re. Claim 66: This claim recites the limitation "**the** position of the content display" in claim's 2nd para. There is insufficient antecedent basis for this limitation in the claim.

According to *Ex parte Pfeiffer*, 135 USPQ 31 (BdPatApp&Int 1961), the court ruled: "As to the rejection of the claims on the prior art references, we do not agree with the appellant that such structural limitations as are not disclosed by the

references should be given patentable weight. This argument is applicable to claims drawn to structure and not claims drawn to a method. To be entitled to such weight in method claims, the recited structural limitations therein must affect the method in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, in our opinion, is the case here."

11. Note About Treatment of Combined References:

A. In re **Keller, Terry, and Davies**, 208 USPQ 871 (CCPA 1981), the court rules: "One cannot show non-obviousness by attacking references individually where rejections are based on combinations of references."

B. In re **Merck & Co., Inc.**, 231 USPQ 375 (CA FC 1986), the court rules: "Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references."

C. In re **Nievelt**, 179 USPQ 224 (CCPA 1973), the court rules: "Combining teachings of references does not involve an ability to combine their specific structures."

D. In re **Bozek**, 163 USPQ 545 (CCPA 1969), the court rules: "Test for obviousness is not whether features of one reference may be bodily incorporated into the other to produce claimed

subject matter but simply what the combination of references makes obvious to one of ordinary skill in pertinent art."

F. "Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art."

G. In re **Honecker Co.**, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998)), the court rules: "**The name of the game is the claim.**"

H. "Although operational characteristics of an apparatus may be apparent from the specification, we will not read such characteristics into the claims when they cannot be fairly connected to the structure recited in the claims". See **In re Self**, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). When given their broadest reasonable interpretation, the claims on examination sweep in the prior art, and the prior art would have directed an artisan of ordinary skill to make the combination cited by the examiner. Cited prior art disclose a structure that meets the claims' limitations. See **Giles Sutherland Rich**, Extend of Protection and Interpretation of Claims -- American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499 (1990) ("The US is strictly an examination country and the main

purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. To coin a phrase, the name of the game is the claim.")

Claim Rejections - 35 USC § 112

12.A. Claims 66, 182, 201, 225 are rejected under 35 U.S.C. § 112, second paragraph, because after they are broken up into their elements for clarity and to which the examiner has added some emphasis read that these claims do not positively recite structural relationships of claim's elements identified as: a means to monitor, computer screens, means to evaluate display positions. In this sense, it fails to comply with section 112, second paragraph, in failing distinctly to claim what applicant insist his actual invention. To be entitled to weight in method claims, the recited structure limitations therein **must affect the method in a manipulative sense**, and not to amount to the mere claiming of a use of a particular structure, see Ex parte **Pfeiffer**, 1962 C.D. 408 (1961).

B. Requirement of 2nd para. Of 35 U.S.C.112 is not only that claims particularly point out and distinctly claim "the invention" but the "subject matter which the applicant regards as his invention"; this means that applicant must particularly point

out and distinctly claim subject matter sought to be patented;

In re Borkowski, 164 USPQ 642 (CCPA 1970).

C. About claimed subject matters which applicant regards as his invention, 2nd para. "...the rejected claims do, indeed, appear to have been "unduly broad". However, with the benefit of the enlightenment provided by our recent decisions in this area, it is now clear that those claims, if too broad, were so only in the sense that they encompassed more than appellants' manifestly regarded as their invention. Compare, *In re Prater*, 56 CCPA 1381, 415 F.2d 1393, 162 USPQ 541 (1969). As such, they would be in clear contravention of the requirements of the 2nd para., of section 112. See *In re Brower*, 167 USPQ 684 (CCPA 1970).

13. The remaining claims (183-200, 202-224, 226-240), not specifically mentioned, are rejected on 35 USC 112, 2nd para. for incorporating antecedent defects from their respective parent claims by dependency.

14. Claims 66-67, 116, 140, 161 are rejected on 35 USC 112, 2nd para., because those claims merely suggest --in general-- a method/medium for monitoring displays having very broad steps/functions of: receiving a program, monitoring displays, generating data, evaluating content positions, and transferring/transmitting data (instead of giving **more specific limitations** in the body of claims to further clarify claimed

09/490,495
Art Unit 2165

subject matters, these claims essentially repeat general information presented in the preamble; see Examination Procedures for Computer-Related Inventions published on 2/27/1996).

15. The remaining claims (68-85, 117-125, 141-147, 162, 183-200, 202-224, 226-240), not specifically mentioned, are rejected on 35 USC 112, 2nd para. for incorporating above defects from their respective parent claims by dependencies.

16. *Ex parte Rubin*, 5 USPQ2d 1461 (BdPatApp&Int 1987)

Knowledge in the art may have advanced such that results considered incredible are no longer per se incredible.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall **contain a written description** of the invention, and of the manner and process of making and using it, in such **full, clear, concise, and exact terms** as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

17. Claims 66-85, 101-241 contain subject matters which were not described in the specification in such a way as to enable one skilled in the art, to make and use the invention. The above claims are directed to computer program codes as essential elements for "content display monitoring" tasks, but said computer program codes are not disclosed.

09/490,495
Art Unit 2165

18. The following are US Patent case rulings have been mentioned in previous Office Actions:

A. In re **Sheckler**, 168 USPO 716 (CCPA 1971), the court ruled:

It is not necessary that a reference actually suggest changes or possible improvements which applicant made. The PTO can show that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the cited references.

C. In re **Jacoby**, 135 USPO 317 (CCPA 1962), the court ruled:

"Problem cannot be approached on basis that workers in the art would know only what they could read in references; those skilled in radiator art must be presumed to know something about radiators apart from what references disclose", "it is immaterial that reference does not disclose specific function set forth in applicants' specification, since this is merely an additional attribute possessed by reference structure which would be obvious to one skilled in the art in a use which one skilled in the art, following teachings of prior art, might make of it".

D. **Merck & Co. Inc. v. Biocraft Laboratories Inc.**, 10 USPO2d 1843 (CA FC 1989), the court ruled:

A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments.

E. In re Heck, 216 USPO 1038 (Fed. Cir. 1983), the court ruled:

"The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain."

F. In re Keller, Terry, and Davies, 208 USPO 871 (CCPA 1981), the court ruled:

"It is not necessary that device shown in one reference can be physically inserted into device shown in other reference to justify combining their teachings in support of rejection."; and "Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art."

G. Ex parte Rubin, 5 USPO2d 1461 (BdPatApp&Int 1987), the court ruled: Knowledge in the art may have advanced such that results considered incredible are no longer per se incredible.

H. In re Conrad, 169 USPO 170 (CCPA 1971), the court ruled:

The test for obviousness under 35 U.S.C. 103 is not the express suggestion of the claimed invention in any or all of the references but what the references taken collectively would suggest.

09/490,495
Art Unit 2165

I. About Method-of-Use claims: When considering a method-of-use claim(steps for operating a specific structural assembly), patentable weight is given to the structure on which the claimed process is carried out in determining the obviousness of that process; *In re Kuehl*, 177 USPQ 250 (CCPA 1973); and

J. About structural limitations in method claims :

To be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure, *ex parte Pfeiffer*, 1962 C.D. 408 (1961).

K. About a basis for claiming criticality:

It is an established principle of law that a limitation merely with respect to proportions in a composition of matter or process will not support patentability unless such limitation is "critical". (e.g. , *Minerals Separation, Ltd. v. Hyde*, 242 U.S. 261 (1916)).

L. In re Conrad, 169 USPO 170 (CCPA 1971), the court said:

The test for obviousness under 35 U.S.C. 103 is not the express suggestion of the claimed invention in any or all of the references but what the references taken collectively would suggest.

09/490,495
Art Unit 2165

M. The type of claims here are very common among software patents, and claiming the desired functional features of the invention, without limitation to its implementation. That is, the claim can be viewed as covering the steps necessary from a business perspective to achieve the desired business goal of providing content monitoring. Thus, software, claimed at the level of useful functionality must have implementation limitations. Claims need to be limited to low level manipulations.

5. The following rejections are based on the examiner's broadest reasonable interpretation of the claims; In re Pearson, 181 USPQ 641 (CCPA 1974).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

19. Claims 116, 163 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Viewing as a whole, claims 116, 163 must include a computer-implemented method in the preamble to clarify a field of use for the claimed subject matter (See at least the specification for the obvious use of a computer system/(a computer network) in this application).

B. Claims 117-125, and 164-166 are rejected for incorporating a defect from their parent claims by dependencies.

C. Claim 66 recites the limitation "monitoring the display of content"; and "monitoring the position" in 1st & 3rd lines of claim 66. There are insufficient antecedent basis for these features in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

20. Claims 66-85, 101-241 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Curran et al. (UK Patent GB 2250112A), in view of Brown (Using Netscape 2 - Special Edition), Capps (US Pat.), and further in view of the Official Notice.

Curran et al. disclose a system/method/computer-readable medium for monitoring displays by a computer system, comprising:

- instructions for causing the content to be displayed by a computer system (inherently in Curran et al.'s patent);

- means/step/instructions for monitoring a position/a change in time of an image on a display screen (of a content characteristic) (see Curran et al., pp. 4:9-12, 5:3-8, 17-23);

Curran et al. don't discuss a means for determining a duration of each time if a display is hidden by other images.

Brown --this reference was supplied in the parent case 's Office Action-- further suggests there is a means/instructions for determining a duration of each time if a display is hidden by other images (see Brown, pp. 270, 805, 720-721) (this is also a limitation in claim 66 about evaluating a position of a content display). Furthermore, Capps clearly discloses that fact with Figs. 7 & 10, 12:64-67 and

- means/step/instructions for monitoring/evaluating/ comparing/judging a position/a change in time of an image on a display screen (see Curran et al., pp. 5:6-7 and 5:13-16).

Curran et al. do not expressly disclose about transmitting monitoring information between sites in response to a signal.

However, Brown (Using Netscape 2 - Special Edition) obviously suggests that feature.

Furthermore, the Official Notice is taken here that a step of receiving a specific program (e.g. a monitoring program) over the Internet (e.g. in claim 148); downloading data to a specific address, downloading time, uploading data/(time duration) (e.g. in claim 167) is notoriously well-known in computer art.

The examiner submits that these claims' limitations are obvious because Curran et al., Capps, and Brown need not necessary spelled-out exactly claimed languages, because their suggestions also directed to a similar system for monitor displaying/controlling; their limitations are not limited to described embodiments in these disclosures. It is reasonable that various modifications and variations of their systems/steps would be apparent to those skilled in the art at the time of invention without departing from the scope and spirit of the invention. Although their disclosures have been described in connection with specific preferred embodiments, it should be understood that their limitations should not be unduly limited to such specific embodiments. It is to be understood that various changes and modifications can be effected therein by one skilled in the art without departing from the spirit or scope of the cited prior art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to implement Curran et

09/490,495
Art Unit 2165

al. 's system with Brown & Capps 's suggestions because it increases a completeness in monitoring a display of content by a computer system.

21. Claims **66-85, 101-241** are rejected under 35 U.S.C. §103(a) as being unpatentable over Curran et al. (GB 2250112 - 5/27/92), in view of Brown (Using Netscape 2 - Special Edition), in view of Cannon et al. (US Pat. 5,673,382), and further in view of the Official Notice.

The Official Notice is taken here that all communications over a network (e.g. Internet) to different servers coupled to that network are notoriously well-known to a person with skills in the art of networking. Furthermore, the limitation of claim **172** is obvious from claim 167 with uploading specific data (an identifying mark/indicia and a related time amount).

Conclusion

22. Claims **66-85, 101-241** are rejected.

23. These references are considered pertinent to applicant's disclosure.

- Curran et al. (UK Pat. GB 2250112A), Computer testing capture device, 05/27/1992.

- Shibata et al., (US Pat. 5,835,923 - 11/10/1998), Contents information transmitting/viewing system and method therefor.

09/490,495
Art Unit 2165

- Pan, (US Pat. 5,926,168 -- 7/20/1999), Remote pointers for interactive televisions.
- Tsai, (US Pat. 5,495,581 - 2/27/1996), Method and apparatus for linking a document with associated reference information using pattern matching.
- Capps (US Pat. 5,634,100 - 5/27/1997), System and method for event parameter interdependence and adjustment with pen input.
- Halliday, FastCAD offers speed, 3-D rendering features, InfoWorld, v13n49, pp.98-105, 12/09/1991.
- Halliday, Product Comparison: High-End CAD, InfoWorld, v13n16, pp.55-75, 4/22/1991.
- Lubow, An engineer's guide to AutoCAD, Industrial Engineering, v19n8, pp.ESC18-ESC20, 8/1987.
- Parks et al., New workstation from SunRiver Corp. Offers highest CAD performance at affordable price, Business Wire, s1 p1, 6/11/1990.
- McGrath, The tail-less mouse: is innovative mouse missing more than just a tail?, Computer Graphics World, v11, p117(2), 10/1988
- Lombardi, Windows Word Processors: InfoWorld tests the tools and features in six of the high-end graphical products, InfoWorld, v14n6, pp.78-96, 2/10/1992.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner

09/490,495
Art Unit 2165

Cuong H. Nguyen, whose telephone number is (703)305-4553. The examiner can normally be reached on Monday-Friday from 7:00 AM-3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on (703)308-1344.

Any response to this action should be mailed to:

Amendments

Commissioner of Patents and Trademarks

c/o Technology Center 2100


Washington, D.C. 20231

or faxed to: (703) 308-9051, (for formal communications intended for entry)

Or: (703) 305-0040/308-5397 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900.


Cuong H. Nguyen
Patent Examiner
July 13, 2001